

REMARKS

This application contains claims 1-40, the status of which is as follows:

- (a) Claims 1-20 have been canceled by a previous amendment. The Applicant may prosecute these claims in a continuation application.
- (b) Claims 21-23 have been currently amended.
- (c) Claims 25-34 and 36-40 were added by a previous amendment, and have not been currently amended.
- (d) Claims 24 and 35 have been canceled by the present amendment.

No new matter has been added. Reconsideration is respectfully requested.

Applicant thanks Examiner Bayard for the courtesy of a personal interview with Applicant's representative, Sanford T. Colb (Reg. No. 26,856), held in the USPTO on July 20, 2005. At the interview, Mr. Colb argued the patentability of claims 21-23, 27-28, 32-33, and 38-39 over the cited references, US Patent 6,327,612 to Watanabe and US Patent 6,256,672 to Redpath, and the patentability of claim 24 under 35 U.S.C. 112, first paragraph. The Examiner agreed that claim 24 finds support in the Applicant's specification, and that the rejection of claim 24 under 35 U.S.C. 112, first paragraph would thus be withdrawn. The Examiner also agreed that the rejection of claims 27-28, 32-33, and 38-39 under 35 U.S.C. 103(a) would be withdrawn if the Applicant files a statement of common ownership of the present application, Watanabe, and Redpath. The Applicant has included such a statement below. Although agreement was not reached regarding the rejection of independent claims 21, 22, and 23 under 35 U.S.C. 102(e), the Examiner conceptually explained her reason for rejecting these claims. The Examiner suggested that Watanabe anticipates these claims because these claims do not recite that the e-mail message is saved on the *sender's* computer without the attachment, rather than on the *recipient's* computer, as taught in Watanabe. The Applicant has amended these independent claims in accordance with the Examiner's suggestion.

Claim 24, which was added by previous amendment, was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Applicant respectfully traverses this rejection. Claim 24 recites "... saving the e-mail message without the attachment on a computer of the sender." The language of this claim finds nearly verbatim support in the specification as filed, which states that "the user . . .

designat[es] . . . whether a file attached thereto should be saved on the user's computer (as is the default setting of most e-mail programs), or whether only the e-mail message should be saved" (paragraph [0015]). Clearly, a "user" who sends an e-mail is a "sender." As mentioned above, at the interview with Mr. Colb the Examiner agreed to withdraw this rejection.

Claims 21, 22, and 23 were rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe. In order to address the Examiner's concern expressed at the interview and more clearly distinguish the present invention over Watanabe, the Applicant has amended these claims to include the limitation from dependent claims 24 and 35 that the e-mail message is saved *on the computer of the sender* without the attachment. Because this limitation was already present in previously presented claims 24 and 35, these amendments do not raise any new issues after final rejection. Although the Examiner rejected claims 24 and 35 over Watanabe in the official action of May 20, 2005, the Applicant believes, based on the Examiner's comments at the interview with Mr. Colb, that the Examiner now recognizes that the cited portions of Watanabe do not teach or suggest sending an e-mail message and an attachment to a recipient, and saving, *on a computer of the sender*, the e-mail message without the attachment.

In light of these arguments and amendments, the Applicant respectfully submits that independent claims 21, 22, and 23 of the present application are now in a condition for allowance. Dependent claims 25-29, 30-34, and 36-40 depend, directly or indirectly, from independent claims 21, 22, and 23, respectively. Given the patentability of these independent claims, the Applicant respectfully submits that these dependent claims are also allowable. The Applicant has canceled claims 24 and 35, because the limitation of these claims has been incorporated into claims 21, 22, and 23, as discussed above.

Claims 27-28, 32-33, and 38-39 were rejected under 35 U.S.C. 103(a) over Watanabe in view of US Patent 6,256,672 to Redpath. Applicant respectfully traverses this rejection. The present application and the applications that issued as both the Watanabe and Redpath patents were commonly owned by the same person (International Business Machines Corporation) at the time the invention of the present application was made. Both the Watanabe and Redpath patents issued after the February 14, 2001 filing date of the present application, and thus are available as potential prior art against the present application only under 35 U.S. 102(e). Therefore, pursuant to 35 U.S.C. 103(c), the

Watanabe and Redpath patents are not available under 35 U.S.C. 103(a) as potential prior art against the present application. Consequently, claims 27-28, 32-33, and 38-39 are believed to be independently patentable over the cited art.

The Applicant believes the amendments and remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these amendments and remarks, the Applicant respectfully submits that all of the claims in the present application are now in order for allowance. Notice to this effect is respectfully requested.

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Respectfully submitted,



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